

REMARKS/ARGUMENTS

In the outstanding Office Action, claims 1-9 and 16-48 have been rejected as being obvious in view of U.S. Patent Number 4,844,924 issued to Stanley; claims 1-3, 6-21, 23-26, 33, 34, and 36-39 stand rejected as being anticipated by General Mills World Patent Publication WO 02/21936; and claims 27-32 stand rejected as being obvious over the General Mills World Publication. The present application includes independent claims 1, 10 and 41. Independent claim 1 is directed to a method of treating a grain based product bran by reacting the bran, which has a native ferulic acid concentration, with 0.1 to 1 parts ozone per 100 parts bran to produce treated bran having a reduced ferulic acid finished concentration of less than 30 ppm. Method claim 10 is more specific in requiring a method of treating a grain based product bran by reacting the bran with ozone to reduce a ferulic acid concentration, acidifying the bran to reduce the pH to about 4-6 prior to treating with ozone, treating the bran with a chelating agent prior to acidifying and blanching the treated bran. Finally, claim 41 represents a broad grain product claim requiring a cereal bran to have a ferulic acid concentration of less than 30 ppm and an elevated concentration of vanillin.

With respect to the application of the World Publication, the Examiner is initially being made aware that the World Publication and the present application are commonly assigned. Therefore, the World Publication does not constitute prior art for purposes of any obviousness-type rejection. With respect to the anticipatory rejections, the test for patentability under 35 U.S.C § 102 is basically whether a single reference teaches or enables each of the claimed elements of the claimed subject matter (arranged as in the claim) expressly or inherently as interpreted by one of ordinary skill in the art. *W.L. Gore and Associates v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), Cir. denied, 469 US 851 (1984). “A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as

complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor co.*, 868 F.2d. 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Simply stated, the World Publication is not seen to disclose the particular range of parts ozone to parts bran specified in independent claim 1 or the particular resulting ferulic acid finished concentration thereof. With respect to claim 10, this claim specifically requires acidifying the bran prior to subjecting it to ozone wherein the World Publication discusses subjecting bran to a bleaching process in the presence of an alkaline. Claim 10 also specifies that the blanching process not only inactivates catalase but also peroxidase enzymatic systems which is not seen to be specifically discussed in the World Publication. Given the lack of at least these features, it is respectfully submitted to the Examiner that the WO reference cannot be relied upon to each and every claim limitation. As the WO reference does not constitute prior art under a 103-type rejection, it is submitted that these rejections should be withdrawn. If the Examiner intends to maintain her positions on these matters, it is respectfully requested that the Examiner show exactly where in the WO reference, each and every claimed feature is considered to be clearly disclosed.

With respect to the Stanley patent, there is absolutely no mention of using ozone to reduce ferulic acid levels. At best, the patent teaches to provide color stability through conventional oxidative bleaching agents, such a peroxide, chlorites, peracids and ozone. Even if one were to argue that treating a grain based bran with ozone would result in a reduced ferulic acid concentration, there is certainly no teaching to react the bran with the specific ratio of ozone to parts of bran or to result in the particular ferulic acid finished concentration set forth in independent claim 1. As Stanley does not disclose any ferulic acid level or even mentions vanillin at all, it is considered that this patent does not address the particular limitations of product claim 41.

In general, the Examiner recognizes the deficiencies in Stanley by listing on the bottom of page 2 of the Office Action **ELEVEN** claimed features which are not disclosed

in Stanley. The Examiner then goes on to argue that each of these eleven features is obvious, without any additional teachings in the prior art of record. The test for patentability under 35 U.S.C. §103 is basically whether the differences between the claimed subject matter, considered as the whole, and the prior art would have been obvious at the time the invention was made. Reaching this determination, the skill and content of the prior art, the differences between the prior art and the claimed subject matter and the level of ordinary skill in the art must be considered, along with the relevant secondary issues. *Graham v. John Deere Co.*, 381 U.S. 1, 148 USPQ 459 (1966).

A proper rejection under 35 U.S.C. §103 cannot be based on hindsight knowledge of the invention under consideration for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd. v. Union Oil Co. of Cal.* 218 USPQ 865, 870 (1983) stated:

All the pieces of the present invention were known in the art, ... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art (Case citations).

Further, the CAFC in *In re Gordon*, 221, USPQ 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

In essence, the Examiner has removed all the deficiencies in Stanley by stating that each claimed feature is obvious, without any teaching in the art. Instead, the Examiner has

utilized the claims of the present application as a blueprint to modify at least eleven different aspects of the Stanley disclosure in order to reproduce the claimed invention. References must be evaluated by ascertaining the facts fairly disclosed therein as a whole. It is impermissible to first ascertain factually what [applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant's invention from such prior art. *In re Shuman and Meinhardt*, 150 USPQ 54 (CCPA 1966). As indicated above, the CAFC has already ruled that modifying prior art without a suggestion of the desirability of the modification by the art is improper. In general, the CAFC has routinely shot down these type of "obvious to try" arguments made by Examiners. Instead, it is necessary for the Examiner to provide prior art which would suggest modifications made in connection with obviousness-type rejections. In the present case, there is not just a couple features lacking in Stanley, but an abundance of features. For instance, in the prior Office Action, the Examiner stated on page 5 that there is no teaching of using ozone in the amount claimed. It is unclear why the Examiner still has no teaching on this feature of the invention, yet now finds this feature obvious in view of no teaching in the art. In any case, it is respectfully submitted that the prior art does not teach or suggest the presently claimed invention and, without teachings to the specifically claimed features, the claims should be allowed. Some of the features have been held to be an "obvious matter of choice." The burden is upon the Patent Office to supply the factual basis supporting the rejection. It must be shown why a person skilled in the art would find it obvious to depart from the teachings of a reference, when the issue is an obvious matter of choice. *Lipscombe's Walker on Patents*, Vol. 4, Section 12:14, page 45, citing *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (1967), *In re Bezombes*, 420 F.2d 1070, 164 USPQ 387 (CCPA 1970).

Certainly, it is clear that it is the PTO that has to establish a prima facia case of obviousness and "obvious can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentives supporting the combination." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732

F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and *Ray Geiger*, 815 F.2d 686 (Fed. Cir. 1987). It is also important to note that the mere fact that the prior art disclosures might suggest to one of ordinary skill in the art to try various combinations of known elements does not establish a *prima facia* case of obviousness under 35 U.S.C. §103. *Ray Geiger supra*. Simple stated, Stanley does not disclose or suggest the particulars of the present invention as covered by claims 1 and 41. There is just no motivation to utilize the specific parts ozone to parts bran to achieve the particular ferulic acid finished concentration of claim 1 or to produce a grain product with a cereal bran having the specified ferulic acid concentration and elevated vanillin concentration of claim 41. Therefore, based on the above remarks, withdrawal of the rejections made, allowance of the claims and passage of the application to issue are respectfully requested. If the Examiner should have any additional concerns regarding the allowance of this application, the Examiner is cordially invited to contact the undersigned at the number provided below to establish such an interview in order to further expedite the prosecution of the application.

Respectfully submitted,



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